

1                   **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

2                   Applicants: Leonard et al.

                    Attorney Docket No. BOI-0258US

3                   Serial No.: 10/722,073

                    Group Art Unit: 2166

4                   Filing Date: November 25, 2003

                    Examiner: Ahluwalia, Navneet K.

5                   Title: KNOWLEDGE MULTIPLIER

6                                   **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

7                   To: Mail Stop AF  
8                       Commissioner of Patents and Trademarks  
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15                                   **REMARKS**

16                   The Pre-Appeal Panel (hereinafter "Panel") is respectfully requested to  
17                   consider this Request, which is submitted in accordance with the Pre-Appeal Brief  
18                   Conference Program rules. A summary of the rejected claims is provided in the  
19                   non-final Office action dated December 31, 2007, on pages 4-13 thereof. The  
20                   Applicant summarized the rejections of record in this Request as well. The Panel  
21                   is requested to reconsider the rejections of record in view of the following  
22                   comments and the arguments currently of record. Because of the requirements of  
23                   brevity, Applicant will discuss only independent claims 1 and 15.  
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1        **§101 Rejection of Independent Claim 15**

2        Claim 15 stands rejected under 35 U.S.C. § 101 as being directed to non-  
3        statutory subject matter.

4        Applicant contends that claim 15 recites statutory subject matter at least  
5        because this claim recites *downloading the abstract for the published submission*  
6        *to a first searchable a machine readable memory medium at a first searchable*  
7        *library website, and downloading the published submission to the machine*  
8        *readable memory medium at a second searchable library website*, which are  
9        respective concrete, useful and tangible results (MPEP 2106(II)(A)). Furthermore,  
10       Claim 15 is directed to *a system for ...* and thus the subject matter of Claim 15 is  
11       tangible and concrete in itself. Thus, Applicants assert that Claim 15 recites  
12       statutory subject matter and the §101 rejection there against should be withdrawn.

13       **§103(a) Rejection of Independent Claims 1 and 15**

14       Independent claims 1 and 15 stand rejected under 35 U.S.C. §103(a) as  
15       being unpatentable over U.S. Patent Application Publication No. 2002/0072997 to  
16       Colson et al. (hereinafter “Colson”), in view of U.S. Patent Application  
17       Publication No. 2001/0047362 to Matthew Comroe (hereinafter “Comroe”). In  
18       making out the rejections of claims 1 and 15, the Office argues that the respective  
19       subject matter is obvious in view of the combined teachings of Colson and  
20       Comroe. In fact, the combination of Colson and Comroe proposed by the Office  
21       fails to provide all of the recited features.

22       Colson does not teach or suggest “*wherein the first and second searchable*  
23       *library websites are exclusive to the employer*” as recited by Claims 1 and 15.  
24       (Emphasis added). Rather, Colson discloses that “the method and system of the  
25       present invention allow(s) for *publishing searchable documents ...* for establishing

1 the existence of an on sale bar ... to prevent others from obtaining patent  
2 protection ..." (Paragraph 0008) Colson further discloses "receiving the product  
3 document and adding the product document to the *[publicly accessible] database*"  
4 and "the computer system being operable to receive a product document ... and  
5 add the product document to the *[publicly accessible] database*." (Paragraph  
6 0009) Thus, Colson discloses that the product documents are published on a  
7 *publicly accessible database* for the purpose of establishing a 102(b) on sale bar  
8 (Emphasis added). Therefore, Colson's disclosure and intent are contrary to that  
9 of the Applicants. Comroe fails to cure the foregoing deficiencies of Colson.

10 Additionally, Colson does not teach or suggest "*locating an abstract for a*  
11 *published submission on a technical society website*" as recited by Claims 1 and  
12 15 (Emphasis added). Rather, Colson discloses that "a search engine...searches  
13 the *product document database*... allowing the user access to the *product*  
14 *documents...and receiving a product document and adding the product document*  
15 *to the database*" (Paragraph 0009). Colson further discloses that "the present  
16 invention allows for *publishing searchable documents (hereinafter product*  
17 *documents) providing information about commercially available products...*"  
18 (Paragraph 0008) (Emphasis added). Thus, Colson discloses locating a *product*  
19 *document* which provides information about *commercially available products*.  
20 Colson does *not* disclose "*locating an abstract for a published submission on a*  
21 *technical society website*" as recited by Claims 1 and 15. Comroe again fails to  
22 cure the foregoing deficiencies of Colson.

23 Furthermore, Comroe does not teach or suggest *embedding a hyperlink to*  
24 *the second searchable website into the abstract, the hyperlink being configured to*  
25

1 *display the published submission when invoked, as recited by Claims 1 and 15*  
2 (Emphasis added).

3 The Office conceded that “*Colson does not disclose embedding the*  
4 *hyperlink in the abstract for the full text explicitly as claimed.* Comroe teaches the  
5 hyperlink being embedded in the title for the full text document. (Emphasis added)  
6 (Office Action page 5 and 8) The Office further stated that “*It would be inherent*  
7 *that the hyperlink can be embedded in the abstract for the full text to the article.*”  
8 (Office Action page 5 and 8) (Emphasis added).

9 Applicants respectfully disagree. “To establish inherency, the extrinsic  
10 evidence must make clear that the missing descriptive matter is necessarily present  
11 in the thing described in the reference, and that it would be so recognized by  
12 persons of ordinary skill.” MPEP § 2112 (IV). To be inherent the feature must be  
13 unable to be considered separately from the thing being described because it is an  
14 innate part of that thing. Comroe discloses that a “web page is displayed with the  
15 title and abstract of every matching article. The *title of each article is formatted to*  
16 *link to the full text of the article*” (Paragraph 0050) (Emphasis added). There is  
17 nothing in Comroe to suggest that embedding a hyperlink to the second searchable  
18 website into the abstract is an inherent part of Comroe’s web page. Embedding a  
19 hyperlink into the abstract, as the Office suggests, would be duplicative of the  
20 hyperlink in the title. This duplication would confuse users and if the hyperlink’s  
21 address were to move or be deleted the website administrator would be required to  
22 update both of the hyperlinks. Thus, a website administrator, of ordinary skill in  
23 the art, would not implement multiple hyperlinks to the same data, particularly if  
24 they were adjacent to one another on the same web page.  
25

1 Accordingly, Applicants respectfully submit that Claims 1 and 15 are  
2 allowable over Colson and Comroe, whether taken alone or in combination  
3 (assuming, for the sake of argument, that the references can even be combined in  
4 the manner set forth in the Office Action). Claims 2-7 and 22-28 are allowable at  
5 least by virtue of their direct or indirect dependence from allowable Claim 1. In  
6 turn, Claims 16-21 are also allowable at least by virtue of their direct or indirect  
7 dependence from allowable Claim 15.

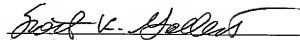
8  
9 **Conclusion**

10 In accordance with the above, the Panel is respectfully requested to reconsider  
11 and withdraw the rejections of the claims. The pending claims are in condition for  
12 allowance. Applicant respectfully requests reconsideration and prompt allowance on  
13 the subject application.

14  
15 Respectfully Submitted,

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17 Dated: June - 11 - 2008

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